

Applicant hereby recognizes that in accordance with 37 C.F.R. §1.193 (b)(2) and MPEP §1208.03, the fee paid for the Notice of Appeal and Appeal Brief will be applied to a later appeal on the present application.

The Examiner has indicated that in response to Applicant's request for reconsideration of the rejection, finality of the last Office Action is withdrawn. This determination is greatly acknowledged.

The Examiner has indicated that additional errors in the original patent have been corrected through amendments to the claims and that therefore, a new/supplemental Oath or Declaration complying with 37 C.F.R. §1.63 and §1.175 is required. Furthermore, claims 1-15 and 46-50 are rejected as being based upon a defective Declaration under 35 U.S.C. §251.

The Examiner has indicated that these requirements may be overcome by receipt of an appropriate Supplemental Oath/Declaration under 37 C.F.R. §1.175 (b)(1). This must be received before the reissue application can be allowed. In response thereto, upon resolution of the presently disputed claims, Applicant will file a suitable New/Supplemental Oath or Declaration in accordance with 35 U.S.C. §251 and 37 C.F.R. §1.175.

Examiner has indicated that claim 49 is objected to as being dependent upon a rejected base claim. This determination is greatly acknowledged.

Claims 46-48 and 50 are rejected under 35 U.S.C. §112, first paragraph. The Examiner contends that the specification, while being enabling for non-destructive chemotaxis assays, does not reasonably provide enablement for any and all types of non-destructive assays. This determination is respectfully traversed.

Independent reissue claim 46, contrary to the Examiner's assertion, is not broadly claiming any or all types of non-destructive procedures. Rather, claim 46 claims a "cell migration assay procedure". It is submitted that the recited steps of the claimed cell migration

assay procedure are sufficiently described so as to enable one skilled in the art to practice the claimed cell migration assay procedure.

Claim 15 of the original patent, which the Examiner has indicated contains allowable subject matter, recites as follows:

**A chemotaxis assay procedure comprising measuring the migration of cells across a radiation opaque membrane, wherein said procedure is non-destructive of said cells.**

Independent reissue claim 46 of the present application recites as follows:

**A cell migration assay procedure comprising measuring the migration of cells across a radiation opaque membrane wherein said procedure is non-destructive of said cells.**

Claim 46 differs from allowed claim 15 only in that the preamble of claim 15 recites a chemotaxis assay procedure while the preamble of claim 46 recites a cell migration assay procedure. It has previously been pointed out to the Examiner that chemotaxis is merely one technique to effect cell migration. While the specification of the present application specifically refers to chemotaxis to effect cell migration, the broad concept required to practice the invention is to effectively induce cell migration across the membrane. The use of a chemo-attractant is merely one method known for inducing such cell migration. The use of a chemo-attractant in the specification merely sets forth the preferred embodiment of causing cell migration. It is cell migration itself, not the manner in which the cells are induced to migrate, which defines the broad aspects of the present invention.

The specification itself notes that cell migration is a more significant aspect of the invention than the particular attractant which induces cell migration. The Examiner's attention is called to column 4, lines 50-54 of the present specification where it recites as follows:

**Accordingly, the radiation measured will provide a direct quantitative measure of the number of cells that have**

**migrated across the radiation opaque membrane 10 from chamber 24 to chamber 22.**

It is clear that the significant feature of the present invention is the measurement of cell migration as opposed to what caused the cells to effect such migration. The present invention centers on the migration of cells across the membrane, particularly a radiation opaque membrane as set forth in claim 46. In that regard, the Examiner's attention is again called to the specification at column 5, lines 30-46, where described in detail is the ability to have labeled cells migrate across a membrane and be measured by electromagnetic radiation which has been used to stimulate the labeled cells. The specification outlines the significant advantage of the present invention in that the claimed assay procedure is non-destructive of the cell sample and thus permits repeated measurements of the same test sample at different time intervals. These features are all described in absence of any requirement that the method of effecting migration be limited to a chemo-attractant. Thus, contrary to the Examiner's position, the specification does, in fact, enable a person skilled in the art to make and use the claimed invention. Reconsideration is respectfully requested.

Claims 46-48 and 50 are rejected under 35 U.S.C. §112, first paragraph. The Examiner contends that while the specification is enabling for chemical agent, it does not provide enablement for any and all types of agents. The Examiner contends that to make and use the invention with an agent other than a chemical agent would involve extensive experimentation. This determination is respectfully traversed.

As noted above, the invention, as contemplated by the inventor, is the ability to effect cell migration across a membrane. One particularly effective technique for effecting cell migration is use of a chemo-attractant. However, there is nothing in the specification that requires the assay procedure to use only a chemo-attractant. One skilled in the art would recognize the existence of various attractants useful to cause migration of cells across a membrane.

In the specification of the present invention, the Applicant has described one particularly useful embodiment with particularity, namely, the use of a chemo-attractant. The Applicant, however, recognizes that scope of the present invention need not be limited to the specific use of

a chemotaxis assay. The specification clearly notes that the claimed membrane may be of any convenient construction "so long as it has the properties mentioned above" (column 6, lines 10-13). Such properties are identified in column 5, lines 30-61 and in other locations in the specification. Any skilled artisan who wishes to practice the claimed cell migration assay would be able, without undue experimentation, to perform the measurement step as recited, as long as the membrane has the properties described and the cells are caused to migrate through the membrane. It may be left to the user to select which is the appropriate technique to cause the migration of cells.

The Applicant has set forth one particularly useful technique, that is, the use of a chemo-attractant to effect cell migration. One skilled in the art would be able to select from a wide number of other techniques useful to effect cell migration. The fact that some experimentation may be required, does not in and of itself rise to the level of undue experimentation as suggested by the Examiner. It is submitted that migration across the claimed membrane may be achieved by assay procedures other than chemotaxis without undue experimentation on the part of one skilled in the art. Reconsideration is respectfully requested.

Claims 46-48 and 50 are rejected under 35 U.S.C. §251 as being improperly broadened in a reissue application. This determination is respectfully traversed.

Contrary to the Examiner's assertion, the present invention does not claim any and all types of non-destructive assays. In fact, the present invention in its broadest scope, is directed to a cell migration assay procedure. This cell migration assay procedure was within the contemplation of the inventor at the time the invention was made, as evidenced by the specification of the present application.

As noted above, the specification repeatedly refers to the ability to permit migration of cells across a radiation opaque membrane. Assays which effect cell migration across such a membrane are within the contemplation of the present invention. Thus, contrary to the Examiner's position, the claims are not directed to all types of non-destructive assays and to all types of inducing agents. Furthermore, Applicant teaches within the specification, assays which

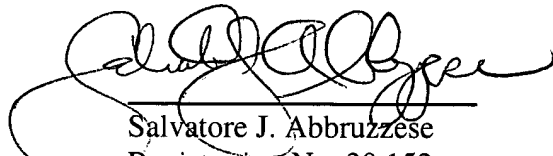
effect cell migration across a radiation opaque membrane as set forth in claim 46. The invention defined in claim 46 being a cell migration assay procedure is adequately supported in it's broad aspect by the specification of the present application. Accordingly, it is respectfully submitted that requirements of 35 U.S.C. §251 are fulfilled and that the claims are not being improperly broadened in a reissue application. Reconsideration is respectfully requested.

It is submitted that the present response addresses each and every rejection noted by the Examiner in the present Office Action and therefore is considered to be complete in all respects. Having now responded, the application is believed to be in condition for allowance. Favorable action thereon is respectfully solicited.

It is respectfully submitted that no fee is occasioned by the submission. However, if a fee is due, the Office is authorized to charge Deposit Account No. 08-2461 for such fee.

Should the Examiner have any questions or comments concerning this submission, the Examiner is invited to contact undersigned counsel.

Respectfully submitted,

  
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